UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte WOLFGANG BREMSER, THOMAS KRUGER, WILMA LOCKEN, STEPHAN SCHWARTE, and HEINZ-PETER RINK

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Appeal No. 2006-2268
Application No. 10/468,448

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ON BRIEF

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Before WALTZ, KRATZ, and JEFFREY T. SMITH, Administrative Patent Judges.

JEFFREY T. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

Appellants appeal the Examiner's final rejection of claims 1 to 14, 16 to 21, and 23 to 27.[1] We have jurisdiction under 35 U.S.C. § 134.

[1]The Examiner has indicated that the subject matter of claims 15 and 22 is allowable, however these claims are objected to as depending upon a rejected claim. (Answer, p. 2).

CITATION OF REFERENCES

The Examiner cites the following references in rejecting the claims on appeal:

Bremser (Bremser '502) WO 01/02502 A1 Jan. 11, 2001
(published World. Intell. Prop. Org. Patent Application)

Bremser (Bremser '448) CA 2377759 Dec. 28, 2001
(published Canadian Intell. Prop. Off. Patent Application)[2]

GROUNDS OF REJECTION

The Examiner entered the following rejections (Answer, pp. 3 to 6);

(I) Claims 13 and 14 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which Appellants regards as this invention.

(II) Claims 1 to 14, 16 to 21 and 23-27 stand rejected under 35 U.S.C. § 102(b) as anticipated by Bremser '502.

(III) Claims 1 to 14, 16 to 21 and 23-27 stand rejected under 35 U.S.C. § 103(a) as obvious over Bremser '502.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and the Appellants regarding the above noted

[2]The Examiner relies on CA 2377759 as an English language translation of the German WO 01/02502 A1 document.

rejections, we make reference to the Answer (mailed May 1, 2006) for the Examiner's reasoning in support of the rejections, and to the Briefs (filed February 10, 2006 and May 25, 2006) for the Appellants' arguments thereagainst.

OPINION

Appellants' invention relates to a polyurethane-modified addition copolymer prepared by free radical copolymerization of an olefinically unsaturated monomer in the presence of the reaction product of (A) an addition copolymer and (B) a polyisocyanate. Representative claim 1, as presented in the Brief, appears below:

> 1. A polyurethane-modified addition copolymer prepared by free radically (co)polymerizing at least one olefinically unsaturated monomer (a) in an aqueous or nonaqueous medium comprising the reaction product (A/B) of
>
> (A) at least one addition copolymer containing on average per molecule at least 0.1 isocyanate-reactive functional groups prepared by free-radical copolymerization in an aqueous medium or nonaqueous medium of at least
>
> a) at least one olefinically unsaturated monomer and
>
> b) at least one olefinically unsaturated monomer different than the olefinically unsaturated monomer (a) and of the general formula I
>
> $$R^1R^2C=CR^3R^4 \qquad (I)$$

> in which the radicals $R^1$, $R^2$,$R^3$, and $R^4$ each independently of one another are hydrogen atoms or alkyl, cycloalkyl, alkylcycloalkyl, cycloalkylalkyl, aryl, alkylaryl, cycloalkylaryl, arylalkyl or arylcycloalkyl radicals, with the proviso that at least two of the variables $R^1$, $R^2$, $R^3$, and $R^4$ are aryl, arylalkyl or arylcycloalkyl radicals; and
>
> (B) at least one polyisocyanate.

Upon careful review of the respective positions advanced by Appellants and the Examiner, we reverse all of the above stated rejections.

35 U.S.C. § 112, SECOND PARAGRAPH REJECTION

Claims 13 and 14 stand rejected under the second paragraph of 35 U.S.C. § 112 as indefinite.

"The legal standard for definiteness [under the second paragraph of 35 U.S.C. § 112] is whether a claim reasonably appraises those of skill in the art of its scope." In re Warmerdam, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). The inquiry is to determine whether the claim sets out and circumscribes a particular area with a reasonable degree of precision and particularity. The definiteness of the language employed in a claim must be analyzed not in a vacuum, but in light of the teachings of the particular application. In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

After consideration of the present record, we determine that a person of ordinary skill in the art would have recognized the disputed claim language covers a polyurethane-modified addition copolymer comprising component (A)(b) comprises at least one olefinically unsaturated monomer selected from the group specified in claims 13 and 14. The Examiner's rejection of the claim is without merit because claims 13 and 14 are dependent upon claim 1 which clearly specifies that more than one olefinically unsaturated monomer can be present as component (A)(b). Thus, the component (A)(b) as specified in claims 13 and 14 is not indefinite or confusing a suggested by the Examiner. Consequently, the Examiner's rejection on this basis is reversed.

PRIOR ART REJECTIONS[3]

The Examiner's rejection of claims 1 to 14, 16 to 21 and 23 to 27 under 35 U.S.C. § 102(b) is reversed. The Examiner acknowledges in the statement of the 35 U.S.C. § 103(a) rejection that there is some selection, i.e., picking and

[3]The Examiner has determined that the German document WO 01/02502 A1 is an appropriate prior art reference under 35 U.S.C. § 102(b). (See Answer, p. 3). Appellants have not challenged this determination by the Examiner in the Briefs. (See the Briefs generally).

choosing, of a combination of ingredients to meet the present claims (See discussion of the 35 U.S.C. § 103 rejection, Answer, p. 5). As such, Bremser '502 does not disclose the same invention as described by the present claims within the meaning of 35 U.S.C. § 102. Accordingly, we determine that the Examiner has not established a prima facie case of anticipation with respect to the subject matter of claims 1 to 14, 16 to 21 and 23 to 27.

Now turning to the Examiner's rejection under Section 103. In making a determination that an invention is obvious, the Examiner has the initial burden of establishing a prima facie case. In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). To establish a prima facie case of obviousness, several basic criteria must be met. There must be some suggestion or motivation, either in the reference or references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1594, 1598 (Fed. Cir. 1988). In addition, all of the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 984-85, 180 USPQ 580,

582-83 (CCPA 1974). Appellants argue that Bremser '502 does not disclose an addition copolymer polymerized in an aqueous medium comprising the reaction product (A/B) of an addition copolymer (A) with an isocyanate-reactive functional groups reacted with a polyisocyanate (B). Appellants further state that Bremser '502 only discloses a cured film that is a reaction product of (A/B), and not a composition with an additional, free radically (co)polymerized copolymer prepared in the aqueous medium comprising the reaction product (A/B) as required by the appealed claims. (Brief, pp. 5-6 and Reply Brief, pp. 3-4). We agree. The Examiner's discussion of the Bremser reference identifies the components which formulate the reaction product of (A/B) as specified by independent claim 1. However, the Examiner has not identified the component which corresponds to the unsaturated monomer (a) as specified in

claim 1.[4] As such, the Examiner has not shown that the Bremser reference renders obvious the subject matter of the appealed claims within the meaning of 35 U.S.C. § 103.

[4]Upon careful review of the cited Bremser reference, we note that component (C) discussed on page 44 of the document may correspond to the unsaturated monomer (a). The Examiner has not provided a discussion of this component and in particular, when this component is added to the Bremser composition. It is noted that the reference discusses the addition of the component (C) as well as other components on pages 56 and 57 of the document. The present record is deficient in that the Examiner has not identified portions of the prior art which establish that a component corresponding to (C) would have been added to the reaction product (A/B) as required by the claimed invention.

CONCLUSION

All of the stated rejections of the pending claims under 35 U.S.C. § 102, 35 U.S.C. § 103, and 35 U.S.C. § 112 are reversed.

REVERSED

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| THOMAS A. WALTZ<br>Administrative Patent Judge | ) | |
| PETER F. KRATZ<br>Administrative Patent Judge | ) | BOARD OF PATENT APPEALS AND INTERFERENCES |
| JEFFREY T. SMITH<br>Administrative Patent Judge | ) | |

JTS/hh

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